



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,625	03/22/2001	Peter Gleichenhagen	tesa AG 719-KGB	6272
27384	7590	12/04/2003	EXAMINER	
KURT BRISCOE NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 12/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

010 13

<b>Office Action Summary</b>	Application No. 09/814,625	Applicant(s) GLEICHENHAGEN ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/06/03 & 08/21/03.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Election/Restrictions**

1. After further consideration coupled with Counsel's persuasive arguments, the non-elected invention (claims 22-30) has been rejoined with the elected invention (claims 12-21). Accordingly, there are no withdrawn claims and all claims will be treated on the merits.

**Information Disclosure Statement**

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 12-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - A) The recited "polymerizing polyacrylate precursor monomers in aqueous dispersion to yield a concentrated aqueous dispersion" per claim 12 constitutes indefinite subject matter as per it not being readily ascertainable as to nexus between the "concentrated aqueous dispersion" and the "polymerizing polyacrylate precursor monomers in aqueous dispersion".
  - B) The recited " $\mu\text{m } \theta$ " per claim 12 constitutes indefinite subject matter as per it not being readily ascertainable as to how the Greek symbol " $\theta$ " further limits the antecedently recited particle size range.

Art Unit: 1713

C) The recited "based on the total weight" per claim 13 constitutes indefinite subject matter as per it is not readily ascertainable as to the exact entity that the contents of "one or more monomers of (meth)acrylic esters with C4-C12 ester radicals", one or more monomers of (meth)acrylic acid or methacrylamide" and "one or more hardening monomers" are being based on. It is suggested that "monomers" be inserted after "total weight" in each instance so as to avoid any ambiguities.

D) The recited "dewatering the concentrated aqueous dispersion in a kneading device or extruder having a devolatizing means operating at a temperature between 90-160 degrees C to form a homogeneous, molecularly-disperse polyacrylate melt, or b) filming the homogeneous, molecularly-disperse polyacrylate melt to form a film by pressing the homogeneous, molecularly-disperse polyacrylate melt through a slot die by means of toothed wheel pumps and/or extruders" per claim 23 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited process per claim 22.

#### Allowable Subject Matter

5. No anticipatory art has been found. Claims 12-30 are deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the meticulously defined process for preparing a hot-melt pressure sensitive adhesive, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate from any of the disclosures of the prior art of record, the precisely defined process for preparing a hot-melt pressure sensitive adhesive, as claimed, with any reasonable expectation of success. The claims would be allowed if rewritten, amended and/or satisfactorily rebutted so as to obviate the 112, 2<sup>nd</sup> paragraph issues raised supra.

#### Response to Arguments

6. Applicant's arguments filed 01/06/03 have been fully considered but they are not persuasive.

Art Unit: 1713

While Counsel, in a good faith effort, attempted to remedy the 112, 2<sup>nd</sup> paragraph issues raised in a previous Office Action (paper no. 8, 09/04/02), new 112, 2nd paragraph issues have come to the Examiner's attention and are as set forth supra.

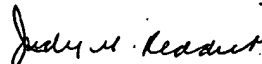
**Conclusion**


7. The prior art listed on the attached FORM PTO-892 is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
11.29.03